

REMARKS

I. Status of the Claims

Applicant respectfully submits this Amendment in reply to the non-final Office Action¹ mailed on November 23, 2010 (the "Office Action"). By this Amendment, Applicant has amended claims 1, 8, and 12. Claim 18 is cancelled. Claims 1, 3, 4, 8-13, 16, and 17 are pending. No new matter has been added via the claim amendments.

II. Interview

As an initial matter, Applicant would like to thank Examiner Foreman for the courtesies extended to Applicant's representatives during the telephonic interview on March 16, 2011. The following remarks reflect the substantive issues discussed during the interview. Should the Examiner disagree with the Applicant's comments on the substance of the interview, she is invited to contact the undersigned at (202) 408-4393 in order to resolve such disagreement.

III. Rejection under 35 U.S.C. § 112, First Paragraph

The Office rejected claim 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection of claim 18. However, solely in the interest of expediting the prosecution of this application, Applicant has cancelled claim 18. Accordingly, the rejection of claim 18 under 35 U.S.C. § 112, first paragraph is moot.

¹ The non-final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the non-final Office Action. Applicant further declines to concede any point that has not been argued herein.

IV. Rejections under 35 U.S.C. § 103(a)

The Office rejected claims 1, 3-4, 7, and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0011650 to Zenhausern et al. ("Zenhausern") in view of WO 02/40874 to Quake et al. ("Quake"), U.S. Patent No. 5,587,128 to Wilding ("Wilding"), U.S. Patent No. 6,743,516 to Murphy ("Murphy"), and U.S. Patent No. 4,015,031 to Reinhardt ("Reinhardt"). Office Action page 4.

Independent claim 1 recites a combination of features, including a microchip comprising a first substrate and a second substrate, "wherein one of the first and second substrates includes a first inlet and a second inlet, the first inlet having received therein a first liquid containing microbeads, the second inlet having received therein a second liquid containing nucleic acid."

A proper *prima facie* case of obviousness requires, *inter alia*, that the prior art references when combined must teach or suggest all the claim limitations. See M.P.E.P. § 2142. As discussed during the interview, the applied references do not appear to disclose that one of the first and second substrates includes a first inlet and a second inlet, the first inlet having received therein a first liquid containing microbeads, the second inlet having received therein a second liquid containing nucleic acid as recited in independent claim 1.

As discussed during the interview, Zenhausern discloses a device used to manipulate analytes via dielectrophoresis ("DEP"). See e.g., Zenhausern at ¶ 23. A sample containing target analytes is introduced into a single channel (400) via an inlet port (401). *Id.* at ¶ 270. A time-varying voltage is applied between field-generating

electrodes (42) and (421), which generate an asymmetrical electrical field within channel (400) due to the constriction point (430), which allows the target analyte to be concentrated therein. *Id.* Zenhausern fails to disclose that one of the first and second substrates includes a first inlet and a second inlet, the first inlet having received therein a first liquid containing microbeads, the second inlet having received therein a second liquid containing nucleic acid. Furthermore, none of the other applied references appear to cure the deficiencies of Zenhausern. Therefore, Applicant respectfully requests allowance of claim 1.

Claims 3-4, 7, and 16-18 depend from independent claim 1, and are therefore allowable for the same reasons independent claim 1 is allowable. Thus, Applicant respectfully requests allowance of claims 3-4, 7, and 16-18.

The Office rejected claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Quake, Wilding, Murphy, and Reinhart as applied to claim 1, and further in view of U.S. Patent No. 5,900,481 to Lough et al. ("Lough") and U.S. Patent No. 6,270,970 to Smith et al. ("Smith"). Claims 8-13 depend from claim 1 and require all the elements of claim 1. As discussed above, combinations of Zenhausern, Quake, Wilding, Murphy, and Reinhart fail to disclose, teach or otherwise suggest a microchip comprising a first substrate and a second substrate, "wherein one of the first and second substrates includes a first inlet and a second inlet, the first inlet having received therein a first liquid containing microbeads, the second inlet having received therein a second liquid containing nucleic acid," as recited in independent claim 1. Lough and Smith fail to cure the deficiencies of combinations of Zenhausern, Quake,

Wilding, Murphy, and Reinhart. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 8-13.

IV. Conclusion

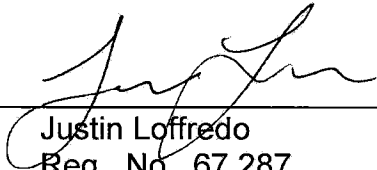
In view of the forgoing remarks, Applicant's respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time required to enter this Amendment and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 17, 2011

By: 
Justin Loffredo
Reg. No. 67,287
(202) 408-4393